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| 09/924,808  | 08/08/2001  | Marcus F. Doemling   | 12729/237 (Y02109US00)    | 2589                   |
| 56020 7590 12/13/2007<br>BRINKS HOFER GILSON & LIONE / YAHOO! OVERTURE<br>P.O. BOX 10395<br>CHICAGO, IL 60610 |             |                      | EXAMINER<br>LEE, PHILIP C |                        |
|   |             |                      | ART UNIT<br>2152          | PAPER NUMBER           |
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

09/924,808

Applicant(s)

DOEMLING ET AL.

Examiner

Philip C. Lee

Art Unit

2152

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 21 May 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-41 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-41 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

1. This action is responsive to the amendment and remarks filed on May 21, 2007.
2. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 5/21/07 has been entered.
3. Claims 1-41 are presented for examination.
4. The text of those sections of Title 35, U.S. code not included in this office action can be found in a prior office action.
5. The disclosure is objected to because it contains an embedded hyperlink and/or other form of browser-executable code (pages 9 and 13 of the specification). Applicant is required to delete the embedded hyperlink and/or other form of browser-executable code. See MPEP § 608.01.
6. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description: reference characters 50 and 51 mentioned in page 12, lines 16-17 of the description. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid

abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

*Claim Rejections – 35 USC 112*

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claims 28-32 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

- a. Claim language in the following claims is not clearly understood:

- i. As per claim 28, line 2, it is unclear if "*when* executed" means anything is actually being executed.

*Claim Rejections – 35 USC 101*

9. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

10. Claims 1-21 are rejected under 35 U.S.C. 101 because according to page 10, lines 6-7 of the specification, “A system” is intended to include software per se, which is not one of the categories of statutory subject matter.

11. Claims 22-27 are rejected under 35 U.S.C. 101 because according to pages 10, lines 6-7 of the specification, “An enhancement *mechanism*” and “a *system*” are intended to include software per se, which is not one of the categories of statutory subject matter.

12. Claims 28-32 are rejected under 35 U.S.C. 101 because according to pages 10, lines 17-18 of the specification, “A program product” is intended to include software per se. “A program product stored on a recordable media can be interpreted as software stored on a media such as paper, which is not one of the categories of statutory subject matter.

*Claim Rejections – 35 USC 103*

13. Claims 1-8, 10-13, 16-27 and 33-38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Auxier et al, U.S. Patent 6,379,251 (hereinafter Auxier) in view of Pettersen, U.S. Patent 6,826,549 (hereinafter Pettersen).

14. Auxier and Pettersen were cited in the last office action.

15. As per claim 1, Auxier taught the invention substantially as claimed for enhancing a content object, comprising:

a system for downloading a network resource from a host server to a client (col. 4, lines 13-20);

a system for downloading an enhancement mechanism with the network resource (col. 4, lines 20-40; col. 9, lines 43-51), wherein the enhancement mechanism includes:

a loading module for requesting and loading the content object from a content server to the client (col. 4, lines 20-40; col. 9, lines 43-51); and

an enhancement module for altering an output format of the content object (col. 4, lines 41-63), and wherein the enhancement module operates on content objects having any of a plurality of formats (col. 4, lines 37-43).

16. Auxier did not specifically teach that the enhancement module rearranges image data of the content object. Pettersen taught a similar system wherein an enhancement module rearranges image data of the content object (col. 11, lines 14-31).

17. It would have been obvious to one having ordinary skill in the art at the time of the invention was made to combine the teachings of Auxier and Pettersen because Pettersen's teaching of rearranging the image data of the content object would increase the flexibility in Auxier's system by allowing a web page to be dynamically rearranged so as to take advantage of dynamically changing conditions. Accordingly, the effectiveness of advertising contained on their web pages can be maximized, and thereby increase the potential revenue generated from an affiliate web site (col. 11, lines 32-39).

18. As per claim 22, Auxier taught the invention substantially as claimed for enhancing content, comprising:

a system for loading a content object for viewing, wherein the content object comprises data stored in a predefined format (col. 4, lines 20-40; col. 9, lines 32-51)(e.g. banner ad to be display for viewing); and

an application programming interface (e.g. java applet) for converting the data from the predefined format to a format compatible with the enhancement module (col. 4, lines 35-53).

19. Auxier did not teach each enhancement module selected from a plurality of enhancement modules causes a different visual alteration of the loaded content object. Pettersen taught a similar system wherein an enhancement module selected from a plurality of enhancement modules, wherein each enhancement module causes a different visual alteration of the loaded content object (col. 11, lines 40-67).

20. It would have been obvious to one having ordinary skill in the art at the time of the invention was made to combine the teachings of Auxier and Pettersen because Pettersen's teaching of selecting a enhancement module, wherein each enhancement module causes a different visual alteration of the content object would increase the flexibility of Auxier's system by allowing a web page to be dynamically rearranged so as to take advantage of dynamically changing conditions. Accordingly, the effectiveness of advertising contained on their web pages can be maximized, and thereby increase the potential revenue generated from an affiliate web site (col. 11, lines 32-39).

21. As per claim 33, Auxier taught the invention substantially as claimed comprising the steps of:

requesting a resource (col. 4, lines 13-19);

retrieving and processing the resource (col. 4, lines 13-19), wherein the resource includes an enhancement mechanism; and

processing the enhancement mechanism, including the steps of:

retrieving a content object (col. 4, lines 20-40; col. 9, lines 43-51);

transferring data from the content object to an enhancement module (col. 4, lines 41-63); and

executing the enhancement module such that the data from the content object is presented (col. 4, lines 41-63).



22. Auxier did not specifically teach that the enhancement module rearranges image data of the content object. Pettersen taught a similar system wherein the enhancement module rearranges the image data from the content object (col. 11, lines 14-31).

23. It would have been obvious to one having ordinary skill in the art at the time of the invention was made to combine the teachings of Auxier and Pettersen because Pettersen's teaching of rearranging the image data of the content object would increase the flexibility in Auxier's system by allowing a web page to be dynamically rearranged so as to take advantage of dynamically changing conditions. Accordingly, the effectiveness of advertising contained on their web pages can be maximized, and thereby increase the potential revenue generated from an affiliate web site (col. 11, lines 32-39).

24. As per claims 2 and 34, Auxier and Pettersen taught the invention substantially as claimed in claims 1 and 33 above. Auxier further taught wherein the network resource is a web page (col. 4, lines 13-20).

25. As per claims 3, 25 and 35, Auxier and Pettersen taught the invention substantially as claimed in claims 2, 22 and 33 above. Auxier further taught wherein the content object is an ad (col. 4, lines 24-27).

26. As per claim 4, Auxier and Pettersen taught the invention substantially as claimed in claim 3 above. Auxier further taught wherein the ad comprises an ad in an industry standard format (col. 4, lines 38-40).

27. As per claims 5 and 36, Auxier and Pettersen taught the invention substantially as claimed in claims 2 and 33 above. Auxier further taught wherein the content object is an image (col. 4, lines 38-40).

28. As per claim 6, Auxier and Pettersen taught the invention substantially as claimed in claim 2 above. Auxier further taught wherein the enhancement mechanism comprises a plug-in embedded in the web page (col. 4, lines 46-53).

29. As per claim 7, Auxier and Pettersen taught the invention substantially as claimed in claim 6 above. Auxier further taught wherein the plug-in comprises an applet (col. 4, lines 46-53).

30. As per claim 8, Auxier and Pettersen taught the invention substantially as claimed in claim 1 above. Auxier further taught wherein the content server is an ad server (col. 4, lines 33-34).

31. As per claim 10, Auxier and Pettersen taught the invention substantially as claimed in claim 8 above. Auxier further taught wherein the host server acts as the ad server (fig. 5; col. 9, lines 23-51).

32. As per claims 11, 23 and 37, Auxier and Pettersen taught the invention substantially as claimed in claims 1, 22 and 33 above. Auxier further taught wherein the enhancement module converts the content object into a game (col. 5, lines 43-47).

33. As per claim 12, Auxier and Pettersen taught the invention substantially as claimed in claim 3 above. Auxier further taught wherein the enhancement module converts the ad into a game (col. 5, lines 43-47).

34. As per claim 13, Auxier and Pettersen taught the invention substantially as claimed in claim 12 above. Auxier further taught wherein the game overlays the ad (fig. 4).

35. As per claim 16, Auxier taught the invention as claimed in claim 1 above. Auxier further taught wherein the enhancement module instructs the host server to retrieve the content object (col. 20, line 66-col. 21, line 6).

36. As per claim 17, Auxier and Pettersen taught the invention substantially as claimed in claim 1 above. Auxier further taught comprising a proxy system that obtains the content object

from the content server on behalf of the client (col. 17, lines 15-21; col. 20, line 66-col. 21, line 6).

37. As per claim 18, Auxier and Pettersen taught the invention substantially as claimed in claim 2 above. Auxier further taught wherein an enhanced content object is created by replacing an embedded ad with an embedded enhancement module (col. 9, lines 32-51).

38. As per claims 19, 24 and 38, Auxier and Pettersen taught the invention substantially as claimed in claims 1, 22 and 33 above. Auxier further taught wherein the enhancement module alters the output format of the content object by providing an informing enhancement that requests a user action (fig. 4; col. 5, lines 64-67; col. 9, lines 60-67).

39. As per claim 20, Auxier and Pettersen taught the invention substantially as claimed in claim 1 above. Auxier further taught wherein the content object is altered in real-time (col. 4, lines 35-53) (i.e. content object is render without prior adjustment, see specification, page 9, lines 13-15).

40. As per claim 21, Auxier and Pettersen taught the invention substantially as claimed in claim 1 above. Auxier further taught the content object is loaded into the enhancement mechanism is one of a plurality of formats that do not require customization (col. 4, lines 35-40).

41. As per claim 26, Auxier and Pettersen taught the invention substantially as claimed in claim 22 above. Auxier further taught wherein the system for loading the content object, the application programming interface, and the selected enhancement module are contained within a web page (col. 4, lines 20-53).

42. As per claim 27, Auxier and Pettersen taught the invention substantially as claimed in claim 22 above. Auxier further taught wherein the system for loading the content object and at least one enhancement module are implemented as Java applets (col. 4, lines 46-53).

43. Claims 39, 40 and 41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Auxier and Pettersen in view of "Official Notice".

44. As per claims 39, 40 and 41, although Auxier taught the message is overlaid on top of the content object (fig. 4), however, Auxier and Pettersen did not specifically detailing all of the different location where a message corresponding to the content object is displayed. "Official Notice" is taken for the concept of displaying a message at different area corresponding to the connect object in a web page is known and accepted in the art. It would have been obvious to one having ordinary skill in the art at the time of the invention was made to include different location where the message is displayed because by doing so it would increase flexibility of Auxier's and Pettersen's systems by allowing the message to be display on the web page according to the interest of the designer.

45. Claims 9 and 28-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Auxier and Pettersen in view of Landsman et al, U.S. Patent 6,785,659 (hereinafter Landsman).

46. Landsman was cited in the last office action.

47. As per claim 9, Auxier and Pettersen taught the invention substantially as claimed in claim 8 above. Auxier and Pettersen did not specifically teach wherein the ad server is a third party server. Landsman taught wherein the ad server is a third party server (col. 11, lines 33-34).

48. It would have been obvious to one having ordinary skill in the art at the time of the invention was made to combine the teachings of Auxier, Pettersen and Landsman because Landsman's teaching of third party server would increase the field of use in the system.

49. As per claim 28, Auxier taught the invention substantially as claimed comprising:  
means for installing an enhancement mechanism into a requested web page that is to be downloaded to a client, wherein the enhancement mechanism includes the enhancement module (col. 4, lines 20-53).

50. Auxier did not teach each enhancement module selected from a plurality of enhancement modules causes a different visual alteration of the passed content object. Pettersen taught a similar system wherein an enhancement module selected from a plurality of enhancement

modules, wherein each enhancement module causes a different visual alteration of the passed content object (col. 11, lines 40-67).

51. It would have been obvious to one having ordinary skill in the art at the time of the invention was made to combine the teachings of Auxier and Pettersen because Pettersen's teaching of selecting a enhancement module, wherein each enhancement module causes a different visual alteration of the content object would increase the flexibility of Auxier's system by allowing a web page to be dynamically rearranged so as to take advantage of dynamically changing conditions. Accordingly, the effectiveness of advertising contained on their web pages can be maximized, and thereby increase the potential revenue generated from an affiliate web site (col. 11, lines 32-39).

52. Auxier and Pettersen did not teach means for selecting and proxy means. Landsman taught a similar comprising:

means for selecting an enhancement module from a plurality of enhancement modules  
(col. 27, lines 1-12); and

proxy means for retrieving a content object on behalf of the client and causing the content object to be passed to the client for viewing (col. 17, lines 15-21; col. 20, line 66-col. 21, line 6).

53. It would have been obvious to one having ordinary skill in the art at the time of the invention was made to combine the teachings of Auxier, Pettersen and Landsman because Landsman's teaching of selecting a enhancement module causing a unique alteration would

increase the flexibility of Auxier's and Pettersen's systems by allowing a enhancement module to change in order to suit a desired environment (col. 27, lines 7-12).

54. As per claim 29, Auxier, Pettersen and Landsman taught the invention substantially as claimed in claim 28 above. Auxier further taught wherein at least one of the enhancement modules converts the content object into a game (col. 5, lines 43-47).

55. As per claim 31, Auxier, Pettersen and Landsman taught the invention substantially as claimed in claim 28 above. Auxier further taught wherein at least one of the enhancement modules comprises an information enhancement (fig. 4; col. 5, lines 64-67; col. 9, lines 60-67).

56. As per claim 30, Auxier, Pettersen and Landsman taught the invention substantially as claimed in claim 29 above. Auxier further taught wherein the content object comprises an ad (col. 4, lines 24-27).

57. As per claim 32, Auxier, Pettersen and Landsman taught the invention substantially as claimed in claim 28 above. Auxier further taught wherein the proxy means causes an address of the content object to be modified to point to an address of a host server (col. 17, lines 15-21; col. 20, line 66-col. 21, line 6).

58. Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Auxier and Pettersen in view of Eggleston et al, U. S. Patent 6,061,660 (hereinafter Eggleston).



59. Eggleston was cited in the last office action.

60. As per claim 14, Auxier and Pettersen taught the invention substantially as claimed in claim 12 above. Auxier and Pettersen did not teach a plurality of smaller images that can be relocated by an end user. Eggleston taught wherein the game partitions the ad into a plurality of smaller images that can be relocated by an end user (col. 30, lines 24-46; col. 36, lines 20-36).

61. It would have been obvious to one having ordinary skill in the art at the time of the invention was made to combine the teachings of Auxier, Pettersen and Eggleston because Eggleston's teaching of smaller images that can be relocated by an end user

62. Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Auxier and Pettersen in view of Erlichman, U.S. Patent 6,790,138 (hereinafter Erlichman).

63. Erlichman was cited in the last office action.

64. As per claim 15, Auxier and Pettersen taught the invention substantially as claimed in claim 12 above. Auxier did not specifically detailing the location of the game. Erlichman taught wherein the game resides in an area outside of the ad (col. 6, lines 35-49).

65. It would have been obvious to one having ordinary skill in the art at the time of the invention was made to combine the teachings of Auxier, Pettersen and Erlichman because Erlichman's teaching of location of the game would increase flexibility of Auxier's and Pettersen's systems by allowing the advertisement to be display on the web page according to the interest of the advertiser.

66. Applicant's arguments with respect to claims 1-41, filed 05/21/07, have been fully considered but they are not persuasive.

67. In the remarks, applicant argued that:

- (1) Pettersen fails to teach rearranging image data from content objects.
- (2) Pettersen fails to teach wherein each enhancement module causes a different visual alternation of the loaded content object.

68. In response to point (1), Pettersen teaches rearranging contents (i.e., content object)(col. 11, lines 30-31), wherein the content include graphics (e.g., images (col. 12, lines 38-40). Therefore, Pettersen teaches rearranging image data from content objects. Furthermore, Pettersen teaches changing dynamic contents (e.g., revenue links) (col. 11, lines 21-23) that have arranged as banner ads one time to buttons and hyperlinks another time (col. 11, lines 62-67)(i.e., rearranging image data from content objects).

69. In response to point (2), Pettersen teaches different visual alternation of the content object (e.g., revenue links) as explained above (col. 11, lines 21-23). Pettersen further teach dynamic content (i.e., content object) is read by the user system in order to perform action in relation to the web page (col. 10, lines 42-50). This means the dynamic content must be placed in memory of the user system for execution (i.e. loading of the content object) in order to be displayed as banner ads, buttons or hyperlinks. Therefore, Pettersen teaches enhancement module causes a different visual alternation of the loaded content object (i.e., dynamic content that was read by the user system).

70. A shortened statutory period for reply to this Office action is set to expire THREE MONTHS from the mailing date of this action. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Philip C Lee whose telephone number is (571)272-3967. The examiner can normally be reached on 8 AM TO 5:30 PM Monday to Thursday and every other Friday. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Bunjob Jaroenchonwanit can be reached on (571) 272-3913. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions

Application/Control Number:  
09/924,808  
Art Unit: 2152

Page 19

on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

P.L.

A handwritten signature in cursive script, appearing to read "Philip Lee". The signature is written in black ink and is positioned to the right of the "P.L." text.